

Application No. 10/713,442  
Amendment dated October 13, 2004  
Reply to Office Action of April 13, 2004

## REMARKS

### **I. Introduction**

Applicant thanks the Examiner for the indication of allowable subject matter. The Examiner has indicated that claims 3-10 and 17-37 would be allowable if rewritten or amended to overcome the objection of the drawings.

The drawings have been objected to under 37 C.F.R. § 1.83(a) for not showing every feature of the invention specified in the claims. Claims 2-10 are objected to for informalities due to the recitation of "a conductor" in claim 2. Claims 1 and 11 are rejected as being anticipated by U.S. Patent No. 5,674,079, to Auclair. Claims 1-2, 11-12, and 38-39 are rejected as being anticipated by U.S. Patent No. 6,652,295, to Glass, et al. Lastly, claims 13-16 are rejected as being obvious in view of Glass, et al.

The Office Action states the "application currently names joint inventors" and requests that the Applicant "point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a)." As the present application names only a single inventor, Mr. George J. Franks, Jr., it is presumed that such statements were made in error.

Based on the amendments and remarks submitted herewith, it is believed that the claims presented are allowable, and Applicant respectfully requests reconsideration and allowance of the present application.

### **II. Drawing Objections**

The drawings are objected to under 37 C.F.R. § 1.83(a), and it is suggested that reference numbers be shown or added to the drawings for an electrical connector, a first conductive structure, a second conductive structure, and a third conductive structure,

The Applicant respectfully submits that all features and limitations of claims 1-39 are illustrated in the drawings. For instance and only by way of example, FIG. 1 illustrates a grounding strap 10, which one skilled in the art would understand may be an electrical connector that is in "electrical contact" with a conductor 11. (*See, e.g.*, ¶ 0046 and FIGS. 1 & 10). The grounding strap 10 may also include several conductive structures, which are further illustrated in the drawings. (*See, e.g.*, ¶¶ 0041-0046 and FIGS. 1, 10, & 12). Again by way of example, FIG. 10 illustrates a grounding clip 60 which "may be formed from copper or brass." One skilled in the art would understand such materials to be conductive metals. (*See* ¶ 0046). Similarly, a grounding shim 120, illustrated in FIG. 12, "may [also] be formed from copper or brass." (*See* ¶ 0046). Furthermore, a bendable ground strap 12, also illustrated in FIG. 12, "may be implemented by a thin strip of galvanized steel, copper, or other conductive metal." (*See* ¶ 0021). Consequently, the "first conductive structure," "second conductive structure," and "third conductive structure" of an electrical connector recited in the claims are illustrated as each being one of, by way of example, the grounding clip 60, the grounding shim 120, and the bendable ground strap 12 of FIGS. 1, 10 and 12 .

In light of the foregoing, it is respectfully submitted that a proposed drawing correction is unnecessary, and that the objection should be withdrawn.

### **III. Claim Objections**

Claims 2-10 are objected to because of language informalities. Specifically, the term "a conductor" in line 5 of claim 2 is objected to, presumably for lack of antecedent basis. Accordingly, claim 2 has been appropriately amended to substitute "the conductor" for "a conductor."

Therefore, as claims 3-10 are dependent from claim 2, it is believed that the objection should be withdrawn.

#### IV. Claim Rejections

##### A. U.S. Patent No. 5,674,079, to Auclair

Claims 1 and 11 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,674,079 ("the '079 patent"), to Auclair, stating that such reference discloses "the first structure and the second structure [are] made of conductive material with [the] same or generally similar galvanic potentials as the material of the conductor." "Under 35 U.S.C. § 102, every limitation of a claim must identically appear in a single prior art reference for it to anticipate the claim." PPG Indus., Inc. v. Guardian Indus. Corp., 75 F.3d 1558, 1566 (Fed. Cir. 1996).

The '079 patent teaches a Ground Lug relating to "devices for implementing a ground connection between a ground wire and a common ground point." Specifically, the '079 patent teaches a ground lug 10 including a collar 20, a clamping plate 50, and a machine screw 90 such that the ground lug 10 engages and secures a ground wire 12 therein. The collar 20 is "composed of electrically conductive material." Col. 2, line 39. The clamping plate is specified as being "composed of electrically conductive material." Col. 2, ll. 41-42. Furthermore, the clamping plate "may be cut from a sheet or coil of material and shaped in a single stamping operation." Col. 3, ll. 22-24. However, at no point does the reference discuss galvanic potential of, nor specify any material for, any of the structures.

In contrast, the claims specifically describe a relationship between the materials of the structures. Specifically, claim 1 requires "the first structure and the second structure being made of conductive material with same or generally similar galvanic potentials as the material of the conductor," while claim 11 requires "the first structure and second structure being made of metals with the same or similar galvanic potentials as the material of the conductor."

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As the limitations of claims 1 and 11 referring to the galvanic potentials of materials are not described, taught, or otherwise suggested by the reference, Auclair cannot anticipate the claims. Accordingly, it is respectfully requested that the rejection be withdrawn.

B. U.S. Patent No. 6,652,295, to Glass et al.

Claims 1-2, 11-12, and 38-39 are rejected as being anticipated under 35 U.S.C. § 102(e) by, and claims 13-16 are rejected as obvious under 35 U.S.C. § 103(a), in view of U.S. Patent No. 6,652,295 ("the '295 patent"), to Glass et al., stating that such reference includes an "inherent" disclosure that the "properties for the first structure and the second structure [are] made of conductive material with [the] same or generally similar galvanic potentials as the material of the conductor." Claim 2 is dependent from claim 1, claims 12-16 are dependent from claim 11, and claim 39 is dependent from claim 38. As discussed above, a rejection under 35 U.S.C. § 102 requires that "every limitation of a claim must identically appear in a single prior art reference for it to anticipate the claim." PPG Indus., Inc., 75 F.3d 1558, 1566. Furthermore, "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.'" In re Robinson, 169 F.3d 743, 745 (Fed. Cir. 1999) (underlining added for emphasis). See MPEP § 2112.

The '295 patent describes a ground bus 50 including a body section 48 for grounding of a like plurality of modules 16. An external ground conductor 74 may be attached by a terminal 56 against the body section 48 to provide a ground to the device. With reference to the ground conductor 74 and the terminal 56, the '295 patent merely discloses "an assured ground connection between conductor 74 and ground bus 50." Col. 2, ll. 53-54.

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Each claim rejected under the '295 patent requires a relationship between the materials of structures. As stated above, claim 1 requires "the first structure and the second structure being made of conductive material with same or generally similar galvanic potentials as the material of the conductor," and claim 11 requires "the first structure and second structure being made of metals with the same or similar galvanic potentials as the material of the conductor." Furthermore, claim 38 requires that "the first structure and second structure are formed from metals with the same or similar galvanic potentials as the material of the conductor."

As noted in the specification, the CRC Handbook of Chemistry and Physics, 75<sup>th</sup> Ed. (1995) lists the galvanic series, which provides the relative galvanic potential of, compounds, metals, and alloys. Spec. ¶ 0041. Clearly, and as discussed in the specification, one skilled in the art would understand that just because materials are conductive *does not* mean that such materials have the same or similar galvanic potential. Spec. ¶ 0041.

The '295 reference does not disclose any information that would teach or suggest the limitations of the present claims with respect to galvanic potential. Furthermore, there is nothing disclosed in the references, singly or in combination, that demonstrates "that the missing descriptive matter is necessarily present." A recitation of a 'ground connection' by the '295 at most permits a possibility of materials as described. "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." In re Robinson, 169 F.3d 743, 745 (underlining added for emphasis). Accordingly, the reliance on inherency is inadequate, and the '295 cannot anticipate or make obvious the above-noted claim limitations.

Accordingly, withdrawal of the claim rejections based on the '295 is respectfully requested.

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## V. Conclusion

Applicant respectfully submits that claims 1-39 are in condition for allowance, which is respectfully requested. If there are any questions or comments, the Examiner can contact the undersigned at the telephone number set forth below. The Commissioner is hereby authorized to charge any additional fees which may be required in the Application to Deposit Account No. 06-1135.

Respectfully submitted,  
FITCH, EVEN, TABIN & FLANNERY

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